

***Remarks***

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-16 and 18-24 are pending in the application, with 1, 15 and 18 being the independent claims. Claims 1, 15 and 18 are sought to be amended. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

***Rejections under 35 U.S.C. § 103***

Claims 1-2 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,264,958 ("Johnson") in view of Applicants' Previously Submitted Art (APSA). Claims 3-16 and 18-24 were rejected under 35 U.S.C. §103(a) as being unpatentable over Johnson in view AAPA, and in further view of U.S. Patent No. 5,559,967 ("Oprescu"). Applicants respectfully traverse these rejections.

To establish a *prima facie* case of obviousness, three criteria must be met. First, some motivation or suggestion must exist in the references or in the knowledge generally available to one of ordinary skill in the art to modify the references. *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991). Second, the references must reveal a reasonable expectation of success. *Id.* Finally, the references must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981 (CCPA 1974).

Claim 1 is patentable over Johnson and APSA for at least the following reasons:

(1) Johnson and APSA, considered alone or in combination, do not teach or suggest each and every element of claim 1 as amended; and (2) the Office Action reliance on Johnson is improper because it is a non-analogous reference.

Claim 1 has been amended to recite:

wherein the interface can transmit and receive a signal and can electronically change between the first and the second standard depending on the signal being transmitted or received.

Support for this amendment can be found in the application paragraph [0037], "[c]ontrol circuits and devices... are used to switch... between Legacy and Beta modes, depending on signals being transmitted or received."

Johnson teaches away from switching between standards depending on the signal being transmitted or received. Instead, as the Examiner references on Page 2 of the Office Action, Johnson teaches using a cable to switch between the two standards. For example, Johnson teaches a set of cables where "[e]ach particular cable is configured for preconditioning signals conforming to a particular electrical interface standard." (Johnson, column 4, lines 22-24). Additionally, APSA does not teach switching between standards, and does not overcome the deficiency of Johnson. Therefore, claim 1 is patentable over Johnson and APSA alone or in combination. Claims 15 and 18 have been similarly amended to include the feature of switching between standards depending on the signals being transmitted or received. As discussed above, Johnson and APSA fail to teach this feature; therefore, claims 15 and 18 are patentable over Johnson and APSA alone or in combination for the above reasons.

Claims 2-14, 16 and 19-24 depend from now allowable claims 1, 15 and 18. For at least the reasons provided above with respect to claims 1, 15 and 18 and further in view of their own features, claims 2-14, 16 and 19-24 are patentable over Johnson and APSA, alone or in combination.

Furthermore, as described above, in order to establish a *prima facie* case of obviousness, "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings." MPEP §2142. "The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).

No suggestion or motivation to combine the references to achieve Applicants' invention is explicitly present in Johnson or APSA. The Examiner does not rely on or point to an explicit suggestion or motivation in the references. Instead, the Office Action makes the following broad conclusory statement:

"[I]t would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined [APSA's] teaching of bilingual ports in IEEE 1394 ports with the teaching of Johnson, for the purpose of increasing compatability among devices that comply with the [legacy] and [beta] standards, which are well known to have much faster data transfer rates than the standards used in Johnson"

(Office Action, p. 3). Thus, it appears that the Examiner is implying that the suggestion or motivation to combine the references is implicit in Johnson and APSA. The test for "an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370

(Fed. Cir. 2000). The Examiner further classifies APSA and Johnson as being in the same field of endeavor, "bilingual ports in IEEE 1394 ports." (Office Action, p. 3). However, the interface in Johnson teaches using standard-specific cables to transmit and receive V.35 (ITU standard approved 1988; <http://www.itu.int/rec/T-REC-V.35/en>) and X.21 (ITU standard approved 1992; <http://www.itu.int/rec/T-REC-X.21/en>) signals. Applicants' argue that APSA and Johnson are non-analogous art and it would not be obvious to one of ordinary skill in the art to combine the interface system of Johnson, with standard-specific cables, with the IEEE 1394 standards in APSA. Therefore, Applicants' respectfully request that the Examiner point to an explicit motivation to combine in the cited references.

Because (1) Johnson and APSA, considered alone or in combination, do not teach or suggest each and every element of claims 1, 15 and 18 as amended; and (2) the Office Action reliance on Johnson is improper because it is a non-analogous reference claims 1, 15 and 18, Applicants' respectfully requests that the Examiner reconsider and withdraw the rejections. Also, at least based on their dependencies and further in view of their own features, Claims 2-14, 16 and 19-24 should be found allowable over the applied references.

### ***Conclusion***

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the

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outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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